



**UNITED STATES DEPARTMENT OF COMMERCE**  
**Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/559,794      04/27/00      PALUMBO

J      49464-(849)

EXAMINER

IM22/0907  
DIKE, BRONSTEIN, ROBERTS & CUSHMAN  
INTELLECTUAL PROPERTY PRACTICE GROUP  
EDWARDS & ANGELL  
P.O. BOX 9169  
BOSTON MA 02209

SHORT, P

ART UNIT

PAPER NUMBER

1712

DATE MAILED:

~~09/07/01~~

*remailed*

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/559794

Applicant(s)

Palumbo et al

Examiner

Short

Group Art Unit

1712

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on July 27, 2001
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-62 is/are pending in the application.
- Of the above claim(s) 14-16, 24-26, 30-33, 48, 49, 56-58 is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-13, 17-23, 27-29, 34-47, 50-55, 59-62 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
  - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 2
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

Office Action Summary

Art Unit: 1712

Claims 48 and 49 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Applicant timely traversed the restriction (election) requirement in Paper No. 5.

Claims 14-16, 24-26, 30-33 and 56-58 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 5.

Applicant's election with traverse of Group I in Paper No. 5 is acknowledged. The traversal is on the ground(s) that there is no undue burden. This is not found persuasive because of reasons given in the restriction requirement. Applicant has not presented appropriate showings or evidence to rebut the prima facie showing of a serious burden based upon separate classification. See MPEP 803

The requirement is still deemed proper and is therefore made FINAL.

Applicant's election with traverse of ABA block copolymers of polyalkylene oxide and dimethylsiloxane in Paper No. 5 is acknowledged. The traversal is on the ground(s) that all of the species belong to the genus of low polarity block segments. This is not found persuasive because of reasons given in the election requirement. If applicant's traversal is based on the ground that the species are not patentably distinct, then applicant should submit evidence or identify evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case.

The requirement is still deemed proper and is therefore made FINAL.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

Art Unit: 1712

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-12, 17-22, 35-47, 50-54 and 60-62 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Lin. The reference teaches a method of preparing a silicone containing polyester coating composition comprising reacting a difunctional alcohol and a dicarboxylic acid with a silicone resin. See examples. As it is not clear what is encompassed by a low polarity polymeric block and substantial adhesion, this rejection is made under 35 U.S.C. 102/103.

Claims 1-13, 17, 20-22, 37-47, 50-53 and 60-62 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Policastro. The reference teaches a method of preparing a polyester-siloxane block copolymer comprising reacting a difunctional alcohol and a dicarboxylic acid with a siloxane resin. See examples. The block copolymers are useful as adhesives and coatings. See col .4, lines 43-47. As it is not clear what is encompassed by a low polarity polymeric block and substantial adhesion, this rejection is made under 35 U.S.C. 102/103.

Claims 1-13, 17-23, 37-47, 50-53, 55 and 60-62 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Peters '158. The reference teaches a method of preparing a polyesteramide-polyisobutylene block copolymer comprising reacting a difunctional alcohol and a dicarboxylic acid with a polyisobutylene. The

Art Unit: 1712

block copolymers are useful as an adhesive. See col. 14, lines 25 through col. 15, line 52 and example 17. The claims do not exclude a diamine monomer. As it is not clear what is encompassed by a low polarity polymeric block and substantial adhesion, this rejection is made under 35 U.S.C. 102/103.

Claims 37-47, 50-54 and 62 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over each of Hallgren and Eichenauer. Each of the references teaches a method of preparing a polyester-siloxane block copolymer that comprises incorporating a polysiloxane block into a copolyester chain. See examples. The block copolymers are useful as adhesives. See Hallgren at col. 1, line 32-36 and Eichenauer at col. 4, lines 16-18. As it is not clear what is encompassed by a low polarity polymeric block and substantial adhesion, this rejection is made under 35 U.S.C. 102/103.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-13, 17-23, 27-29, 34-47, 50-55 and 59-62 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are indefinite because, it is not clear what is encompassed by a low polarity polymeric or oligomeric block and thus, when the claims would be infringed. Additionally, it is not clear what constitutes substantial adhesion. Finally, the language "such as" used in claim 21 is indefinite because it is not clear whether it further limits the claim.

Application/Control Number: 09/559,794

Page 5

Art Unit: 1712

P. Short

September 5, 2001

Phone (703) 308-2395

Fax (703) 872-9310

PATRICIA A. SHORT  
PRIMARY EXAMINER

*Patricia A. Short*